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In The

Supreme Court of the United States

October Term, 1979

No. 79-454

SHURE BROTHERS, INCORPORATED,

Petitioner,

vs.

KORVETTES, INC., d/b/a E. J. KORVETTE,

Respondent.

On Writ of Certiorari to the United States Court of Appeals for the Seventh Circuit

BRIEF IN OPPOSITION

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TABLE OF CONTENTS

	Page
Introduction	1
The Question Presented for Review	2
Statement of the Case	2
Historical Perspective	2
The Nature of the Case and Disposition in the Courts Below	3
The Technology Covered by the Patents	4
Argument:	
I. The decision of the court of appeals is correct.	5
II. Shure has not shown the requisite public interest in these patents warranting any review by this Court.	8
A. No Conflict Between Courts of Appeal	8
B. These Patents Are of No Widespread Public Concern	9
Conclusion	10

TABLE OF CITATIONS

Cases Cited:

Aro Mfg. Co. v. Convertible Top Replacement Co., 365 U.S. 336 (1961)	6

Contents

Page

Exhibit Supply Co. v. Ace Patents Corp., 315 U.S. 126 (1942) 7

Graver Tank & Mfg. Co. v. Linde Air Products Co., 336 U.S. 271 (1949) 6

Hubbell v. United States, 179 U.S. 77 (1900) 7

I.T.S. Rubber Co. v. Essex Rubber Co., 272 U.S. 429 (1926). 7

Lear, Inc. v. Adkins, 395 U.S. 653 (1969) 9

Milcor Steel Co. v. George A. Fuller Co., 316 U.S. 143 (1942) 6

Morgan Envelope Co. v. Albany Paper Co., 152 U.S. 425 (1894) 7

Sanitary Refrigerator Co. v. Winters, 280 U.S. 30 (1929) ... 8

Sargent v. Hall Safe & Lock Co., 114 U.S. 63 (1885) 7

Schriber-Schroth Co. v. Cleveland Trust Co., 311 U.S. 211 (1940) 7

Shepard v. Carrigan, 116 U.S. 593 (1886) 7

Shure Brothers, Inc. v. Peeltone, Inc., Civil Action No. 76-722 (D. Md. Dec. 5, 1978) 8

Shure Brothers, Inc. v. Tower Records, Inc., Civil Action No. C76-964 (N.D. Cal.) 2

Smith v. Magic City Kennel Club, 282 U.S. 784 (1931) 7

Contents

Page

Universal Oil Products Co. v. Globe Oil & Refining Co., 322 U.S. 471 (1944) 6

Weber Elec. Co. v. Freeman Elec. Co., 256 U.S. 668 (1921) . 7

Rules Cited:

Supreme Court Rule 19(1) 2

F.R.C.P.:

Rule 12(b)(6) 3

Rule 54 4

Rule 56 3

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BRIEF IN OPPOSITION

This brief is submitted on behalf of respondent Korvettes, Inc. (hereinafter "Korvettes"), in opposition to the petition for writ of certiorari filed by petitioner Shure Brothers, Incorporated (hereinafter "Shure").

INTRODUCTION

This is an ordinary run-of-the-mill patent case and there is no basis for issuance of a writ of certiorari here.

The petition presents no special or important reason the writ should be granted. Supreme Court Rule 19(1).

There is no conflict between the decisions of any courts of appeal.

There is no important question of federal law which has not been, but should be, settled by this Court.

There is no conflict with any applicable decision of this Court.

THE QUESTION PRESENTED FOR REVIEW

Did the Seventh Circuit Court of Appeals correctly affirm a summary judgment entered by the United States District Court for the Northern District of Illinois that Shure's United States Letters Patents Nos. 3,077,521 and 3,077,522[1] were not infringed, as a matter of law, by Korvettes.

STATEMENT OF THE CASE

Historical Perspective

The action below was initiated by Shure against Korvettes for alleged infringement of the '521 and '522 patents because of Korvettes' sale of replacement phonograph styli (needles) supplied to it by Walco-Linck Corporation ("Walco").[2] Shure has asserted infringement of only certain claims of these patents.[3]

1. Hereinafter referred to simply as the '521 and '522 patents, respectively.

2. Shure has also instituted suit on these same patents against another Walco customer in California. *Shure Brothers, Inc. v. Tower Records, Inc.*, Civil Action No. C76-964 (N.D. Cal.). That California action and the action at issue here are being defended by Walco on behalf of its customers.

3. The only claims alleged to be infringed are Claims 7 to 13 and 15 of the '521 patent and Claims 2 to 4 and 6 of the '522 patent (A3).

The product accused of infringing the '521 and '522 patents is a replacement stylus for a stereophonic phonograph pickup cartridge. The particular accused replacement stylus is sold to Korvettes by Walco and by Korvettes to the consumer who uses it to replace a worn out stylus in his phonograph record player. Shure was aware of Walco's alleged infringing activities since the issuance of the '521 and '522 patents on February 12, 1963.[4] For eleven years Shure and Walco had sporadic correspondence with respect to continued charges of Walco's alleged infringement and demands to cease such alleged infringing activities. In 1974 Shure ceased direct assertion of the '521 and '522 patents and instead began asserting its patents against various of Walco's customers.

In 1976 Shure filed its action against Tower Records, Inc. in California and in 1977 instituted the action below against Korvettes. Both of these actions were defended by Walco.

The Nature of the Case and Disposition in the Courts Below

The action filed in the district court was for alleged infringement of the '521 and '522 patents. Korvettes, before responding to the complaint, moved to dismiss under Rule 12(b)(6), F.R.C.P., for failure to state a claim upon which relief could be granted. It was Korvettes' contention that the asserted claims of the '521 and '522 patents were combination claims directed to a magnetic phonograph cartridge pickup device in combination with a needle stylus device and that Korvettes' sale of only a needle stylus intended to replace a worn out stylus could not, as a matter of law, be an infringement of the '521 and '522 patent claims at issue.

The district court treated Korvettes' motion as one for summary judgment under Rule 56, F.R.C.P., and in a

4. Shure charged Walco with infringement by letter dated February 12, 1963 and demanded that Walco cease its infringing activities.

memorandum opinion and order (A2), granted summary judgment of non-infringement. After considering and denying Shure's request for reconsideration, the district court (A11), made its entry of summary judgment final under Rule 54, F.R.C.P., and Shure appealed to the Seventh Circuit Court of Appeals. The court of appeals (A1) affirmed the judgment entered by the district court.

The Technology Covered by the Patents

Both patents at issue relate to magnetic phonograph pickup cartridges and a needle stylus assembly used to play stereophonic records having two sound tracks located on opposite sides of a single record groove. The phonograph pickup cartridges (usually housed on the end of a record player tone arm) include two mutually independent magnetic circuits each terminating in a pair of spaced-apart pole pieces arranged to form a common magnetic gap and socket having a recess co-extensive with the magnetic gap. The two pairs of spaced apart pole pieces are offset 90° from each other.

The stylus assembly, which is inserted into the socket formed by the two pairs of pole pieces, includes a permanent magnet, a stylus arm extending from the magnet and a needle stylus at the end of the arm. The permanent magnet is mounted within a resilient bearing material so that the magnet can move or articulate within the recess.

In use, the needle stylus, as it tracks the ridges and valleys impressed within a record's grooves, vibrates causing the permanent magnet to move within the pole pieces associated with the phonograph pickup's magnetic circuits. This movement of the magnet induces a voltage in the magnetic circuits which is converted to sound by suitable amplifiers and loudspeakers. Each mutually independent magnetic circuit corresponds to one "track" of the stereophonic recording.

Korvettes sells only the stylus assembly which includes the permanent magnet mounted in an elastromeric, resilient bearing, the stylus arm and the stylus needle to track within a record's grooves.

ARGUMENT

I.

THE DECISION OF THE COURT OF APPEALS IS CORRECT.

As is set out in detail in defendant-appellee's brief in the court of appeals at pages 10-16, an examination of the file wrapper histories of the '521 and '522 patents[5] reveals that critical limitations had to be added to the preamble to the claims at issue in order to induce the Patent Office to allow the claims over the prior art cited by the Patent Examiner.

To illustrate the type of additional structural limitations added during prosecution of the applications, a comparison of a typical claim preamble as initially filed with the preamble of the patent claims which issued is instructive. As initially filed, claims purportedly directed to the stylus subassembly alone had a preamble which stated:

> "An armature-stylus subassembly for a magnetic pickup cartridge designed for stereophonic reproduction comprising . . ." (SA86-88).

Application claims with the above-quoted preamble were repeatedly rejected by the Patent Office as unpatentable over the

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5. Complete copies of the '521 and '522 patent file histories were filed as defendant-appellee's separately bound supplemental appendix (designated SA) in the court of appeals and which have been certified to this Court as part of the record in this case.

prior art of record. To avoid the Examiner's rejection in view of the prior art, Shure amended the preamble to the relevant claims at issue to recite:

> "An armature-stylus subassembly for a magnetic cartridge *comprised of two electromagnetic systems each terminating in a pair of spaced-apart pole pieces arranged to describe a common magnetic gap and to form a socket having a recess substantially co-extensive with said gap,* said subassembly comprising . . ." (SA131-134). (Emphasis supplied.)

In entering summary judgment of non-infringement, the district court found, and was affirmed by the court of appeals, that the '521 and '522 patent claims, as amended by Shure to avoid prior art rejections advanced by the Patent Office, were directed to the combination of a cartridge pickup device and a needle stylus subassembly. Shure had unsuccessfully tried to induce the Patent Office to allow its purported stylus subassembly claims with only the broad preamble setting forth an environment of intended use. Unfortunately for Shure, it could not obtain allowance of these broader claims. Shure had to narrow its claims by inserting structural limitations directed to the cartridge pickup device, quoted *supra,* and these added limitations converted the application claims from stylus alone to claims covering the combination of the cartridge pickup device and the stylus subassembly.

It is by now axiomatic that the claims made in a patent are the sole measure of the grant. *Aro Mfg. Co. v. Convertible Top Replacement Co.*, 365 U.S. 336, 339 (1961); *Graver Tank & Mfg. Co. v. Linde Air Products Co.*, 336 U.S. 271, 277 (1949); *Universal Oil Products Co. v. Globe Oil & Refining Co.*, 322 U.S. 471, 484 (1944); *Milcor Steel Co. v. George A. Fuller Co.*, 316 U.S. 143, 145 (1942). It is also well-settled that where an applicant for a patent is compelled by a rejection in the Patent

Office to narrow the claim by introducing a new element, the applicant is not entitled to a broad reading of the claim which ignores the element he was compelled to include to obtain his patent. *I.T.S. Rubber Co. v. Essex Rubber Co.*, 272 U.S. 429, 443 (1926); *Shepard v. Carrigan,* 116 U.S. 593, 597 (1886); *Sargent v. Hall Safe & Lock Co.*, 114 U.S. 63, 86 (1885); *Hubbell v. United States,* 179 U.S. 77, 85 (1900); *Morgan Envelope Co. v. Albany Paper Co.*, 152 U.S. 425 (1894); *Weber Elec. Co. v. Freeman Elec. Co.*, 256 U.S. 668, 677 (1921); *Smith v. Magic City Kennel Club,* 282 U.S. 784, 789 (1931); *Schriber-Schroth Co. v. Cleveland Trust Co.*, 311 U.S. 211, 221 (1940); *Exhibit Supply Co. v. Ace Patents Corp.*, 315 U.S. 126, 136 (1942).

Moreover, once an applicant for patent has limited his claim by amendment, if the claim is to a combination of specified elements, all elements must be regarded as material and the limitations introduced by way of amendment, especially after repeated rejections, must be strictly construed. *I.T.S. Rubber, supra,* at 443-4.

In brief, Shure amended its claims in the Patent Office by adding limitations in the claims to the structure of the cartridge pickup device. These amendments were necessary to induce the Patent Office to issue the '521 and '522 patents. Shure cannot now ignore the amendatory matter in the claims. Thus, the claims as they exist in the patents are to a combination of a cartridge pickup device and a stylus subassembly. The claims are not infringed by the sale of a stylus subassembly alone. Thus, the summary judgment of noninfringement entered by the district court and affirmed by the court of appeals is correct.

II.

SHURE HAS NOT SHOWN THE REQUISITE PUBLIC INTEREST IN THESE PATENTS WARRANTING ANY REVIEW BY THIS COURT.

A. No Conflict Between Courts of Appeal

Shure has attempted to magnify the significance of the issue by pointing to an apparently different decision in another circuit.[6] That decision in the district court for the District of Maryland is, on the record presented here, ambiguous at best and, more importantly, is not a decision of a court of appeals warranting a review by this Court because of conflicts between courts of appeal. *See, e.g., Sanitary Refrigerator Co. v. Winters,* 280 U.S. 30 (1929).

The limited record of that Maryland action presented here (A14-16), is inconclusive as to whether any imagined conflict in decisions even exists. No basis is presented for any determination as to what issue was tried in the Maryland court. Indeed, after the evidence was presented, Judge Murray stated (A15): "I think the case is factually different from the *Shure Brothers v. Korvette's, Inc.* case because the patented device was the combination device described in Claim 7 and Claim 2 in the two patents here at issue."

Thus, it is unclear from this record whether any conflict exists at all between circuits and even if the Maryland District Court decision did conflict with the Seventh Circuit affirmance of summary judgment, the Maryland decision was not appealed and, thus, cannot be said to represent a conflicting decision from another circuit.

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6. *Shure Brothers, Inc. v. Peeltone, Inc.*, Civil Action No. 76-722 (D. Md. Dec. 5, 1978).

B. These Patents Are of No Widespread Public Concern.

Shure also attempts to manufacture an issue of widespread public concern and uncertainty regarding these two patents where none exists. These patents were issued on February 12, 1963. They expire on February 12, 1980, about four months from now. Whatever vitality and public concern these patents may have had is vitiated by the fact that they will be in the public domain in just four months.

Yet Shure argues that there is widespread confusion and uncertainty which will affect the rights and conduct of "a considerable purchasing public, the whole of the phonograph industry, and, more specifically, Shure's long-standing licensees." These arguments are fallacious.

First, Walco, the supplier of Korvettes' accused stylus, is unaware of any other current sales of stylus of the type accused by anyone not licensed by Shure. Thus, no manufacturer can be adversely affected by this decision in the remaining four months. Indeed, Shure's own conduct in failing to directly assert these same patents in an action against Walco, the manufacturer known to Shure since the patents issued, belies the urgency of Shure's complaint of creating confusion for the purchasing public and the phonograph industry.

Second, no member of the consuming public has ever been challenged by Shure for infringement of these patents and it is doubtful that Shure will ever do that so that no purchasing consumer will be affected.

Third, as to Shure's relationships with its licensees, there is no record in this case as to what the licensee's manufacture; what royalties, if any, are paid Shure; and, more importantly, if any of Shure's licensees wish any redress as to royalties due Shure under these patents, those licensees can challenge the scope of these patents under *Lear, Inc. v. Adkins,* 395 U.S. 653 (1969). This is a personal decision between the licensees and

Shure which has no overriding public policy considerations.

In summary, these patents have bearly four months to go. The fact that one court has determined that the sale of replacement styli does not infringe these patents does not create a situation of chaos and uncertainty requiring this Court's attention. Shure's self-serving quotations of accolades accorded its manufactured phonograph pickup are irrelevant and do not create a reason for this Court to grant certiorari.

CONCLUSION

Shure's petition for a writ of certiorari should be denied as there is no overriding reason why the writ should be granted. No conflict between circuit courts of appeal needs to be resolved. There is no important question of federal law of wide applicability which needs to be resolved. The decision below does not conflict with any decision of this Court.

Respectfully submitted,

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